REMARKS

The Office Action of October 18, 2008 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection and objection are traversed and overcome. Upon entry of this Amendment, claims 6, 7, 9, 25 and 26 remain in the application. Claims 1-5 and 10-24 have been withdrawn. Claims 6, 7, 25 and 26 have been amended. Basis for these amendments can be found in the application as filed, at least at page 8, lines 20-24 and in the claims. Reconsideration of the claims is respectfully requested.

Claims 6, 7, 25 and 26 stand rejected under 35 U.S.C. § 112, second paragraph. Specifically, the Examiner asserts that claims 6 and 26 contain improper Markush terminology. Claims 6 and 26 have been amended to change the language of the claims to closed terminology as the examiner requested.

The examiner asserts that claim 7 is ambiguous as it is unclear what remains after evaporation. Claim 7 has been amended to clarify that it is the remaining portion of the vehicle that remains after evaporation.

The examiner objects to the phrase “low toxicity” in claims 7 and 26 as being indefinite. Claims 7 and 26 have been amended to change the phrase to “Generally Regarded as Safe (GRAS) and edible”.

In claim 25, the examiner asserts that it is unclear in the claim whether the components of claim 6 or unnamed components of claim 7 are being referred to. The claim has been amended to make clear that it is the vehicle remaining after evaporation, indeed the vehicle of both claims 6 and 7, that is being referred to.

For the above reasons, the it is submitted that the Examiner’s concerns in the §112, second paragraph rejection should be satisfied and the rejection withdrawn.

Claims 6, 7, 9, 25 and 26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Patel et al. Furthermore, claims 6, 7, 9, 25 and 26 stand rejected over Gardella in view of Patel.

With the amendment of claims 6 and 26 to obtain proper Markush terminology, Applicant asserts that the previous arguments that the pharmaceutical solution

consists essentially of the vehicle and the active pharmaceutical ingredient should be reconsidered. Specifically, the pharmaceutical solution consists essentially of: a vehicle to substantially evaporate from a substrate when deposited thereon; and an active pharmaceutical ingredient with a solubility of at least about 30 mg/ml in the vehicle. The vehicle is at least one selected from the group consisting of: 2-pyrrolidone (2-P), 1,2 hexanediol, sodium xylene sulfonate, ethylene glycol mono-phenyl ether, dimethyl sulfoxide (DMSO), n-methyl pyrrolidone (NMP), hydroquinone, cyclodextrines, and glycerin.

As previously asserted, both Patel and Gardella teach an active pharmaceutical ingredient being combined with a carrier and a small amount of solubilizer. The solubilizer in both Patel and Gardella may be 2-pyrrolidone or several other possible solubilizers. The greatest proportion of the combination pharmaceutical/carrier is taken up by the carrier. The solubilizing ingredients of Patel and Gardella, such as 2-pyrrolidone, are not taught as possible carriers, nor is there the suggestion that they could be used as carriers.

In Applicant's claims, in sharp contrast, the listed vehicle acts as a carrier of the pharmaceutical ingredient until evaporation.

There is no teaching or suggestion in either Patel or Gardella about achieving a liquid form of the pharmaceutical solution that, after being ejected from a thermal fluid ejection device onto a substrate, the vehicle of the pharmaceutical solution very quickly evaporates from the substrate. Neither Patel nor Gardella teach or suggest that a solubilizing component, such as 2-pyrrolidone, could be used alone as a vehicle.

With the amendment of the Markush phrases in claims 6 and 26 to have closed terminology, Applicant requests that the examiner reconsider the previous arguments about the present claims being patentable over Patel and Gardella. With this amendment, the phrase "consisting essentially of", used in both claims 6 and 26, limits the scope of the claims to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed application.

Furthermore, Applicant asserts that it is clear what are the basic and novel characteristics of Applicant's invention as recited in claims 6 and 26.

In response to the Examiner's assertion that intended use of an old composition does not impart patentability, Applicant asserts that she is not relying in the present claims on intended use but rather on the claimed composition itself. For the reasons asserted above, it is submitted that Applicant's claims set out a pharmaceutical solution which is not taught nor suggested by the prior art.

As such, it is submitted that Applicant's invention as defined in independent claims 6 and 26, and in those claims depending ultimately therefrom, is not anticipated, taught or rendered obvious by Patel or Gardella, either alone or in combination, and patentably defines over the art of record.

In summary, claims 6, 7, 9, 25 and 26 remain in the application. It is submitted that, through this Amendment, Applicant's invention as set forth in these claims is now in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicant's Attorney at the below-listed telephone number.

Respectfully submitted,

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